

08-04-05

PATENT APPLICATION

ATTORNEY DOCKET NO. 10004546-1

IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Brian William Hughes et al

Confirmation No.: 7471

Application No.: 09/842,435

Examiner: J. D. Torres

Filing Date: 04/25/2001

Group Art Unit: 2133

Title: SYSTEM AND METHOD FOR MEMORY SEGMENT RELOCATION

Mail Stop AF  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Sir:

Transmitted herewith is/are the following in the above-identified application:

- ( ) Response/Amendment ( ) Petition to extend time to respond  
( ) New fee as calculated below ( ) Supplemental Declaration  
( ) No additional fee  
(X) Other: Petition of Restriction Requirement (fee \$ 130.00)

CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS		MINUS		= 0	X \$50	\$ 0
INDEP. CLAIMS		MINUS		= 0	X \$200	\$ 0
[ ] FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+ \$360	\$ 0
EXTENSION FEE	1ST MONTH \$120.00	2ND MONTH \$450.00	3RD MONTH \$1020.00	4TH MONTH \$1590.00		\$ 0
OTHER FEES						\$ 130
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 130

Charge \$ 130 to Deposit Account 08-2025. At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Date of Deposit August 3, 2005

I hereby certify that this correspondence is being deposited with the United State Postal Service as Express Mail, Label No. EV482709007US in an envelope addressed to:  
Mail Stop AF, Commissioner for Patents, Alexandria, VA 22313-1450

By

Typed Name: Elise Perkins

Respectfully submitted,

Brian William Hughes et al

By

Michael A. Papalas

Attorney/Agent for Applicant(s)

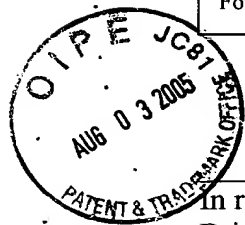
Reg. No. 40,381

Date: August 3, 2005

Telephone No.: (214) 855-8186

HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, Colorado 80527-2400

Docket No.: 10004546-1  
(PATENT)



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Brian W. Hughes et al.

Application No.: 09/842,435

Confirmation No.: 7471

Filed: April 25, 2001

Art Unit: 2133

For: SYSTEM AND METHOD FOR MEMORY  
SEGMENT RELOCATION

Examiner: J. D. Torres

**PETITION OF RESTRICTION REQUIREMENT PURSUANT TO 37 C.F.R. § 1.144**

MS AF  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RELATED MATTERS**

This Petition is being filed concurrently with a Notice of Appeal and Appeal Brief reinstating the appeal filed on February 1, 2005.

**BRIEF SUMMARY OF ACTIONS**

The present application was filed on April 25, 2001 having claims 1-20. A First Office Action was mailed on June 4, 2004, which rejected claims 1-20, objected to the specification, and objected to the drawings filed on April 25, 2001. In response to the First Office Action, claims 1-10 were cancelled, claims 11-13 and 18 were amended, new claims 21-29 were added, and the specification and drawings were amended.

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A Second Office Action was mailed on October 6, 2004, which accepted the drawings as filed on August 30, 2004, rejected claims 18-29, and withdrew claims 11-17 from consideration based upon a restriction requirement. Specifically, the Examiner asserted that "inventions [of] Group I (claims 11-17) and Group II (claims 18-29) are related as process and apparatus for its practice." The Examiner further asserted "the search required for Group I is not required for

Group II, restriction from examination purposes is indicated as proper.” In Response to the Second Office Action, the Applicant traversed the restriction requirement and provisionally elected Group II (claims 18-29) for prosecution. The Applicant pointed out that the restriction was inappropriate as each of the claims in Group 1 and Group II had already been examined. Specifically, the Applicant pointed out that the invention of Group 1 had already been searched by virtue of the Examiner’s prior art rejection in the First Office Action. And, the invention of Group II had already been examined as the Examiner had rejected claims 18-20 in the First Office Action and made an additional prior art rejection of claims 18-29 in the Second Office Action. Therefore, the Examiner could not demonstrate a serious burden as required to issue a restriction requirement.

A Third Office Action (the “Advisory Action”) was mailed on January 3, 2005, which reiterated the Examiner’s position that claims 18-29 stood rejected and claims 11-17 were withdrawn from prosecution by restriction. In the Advisory Action, the Examiner asserted “the requirement is still deemed proper and is therefore made Final.” In response to the Advisory Action, the Applicant filed a Notice of Appeal on February 1, 2005, and filed an Appeal Brief on April 1, 2005.

After the Applicant filed the Appeal Brief, a Fourth Office Action was mailed on May 3, 2005, which purported to be in Response to the Applicant’s First Office Action Response. The Fourth Office Action rejected claims 18-21, and despite the “finality” of the previous restriction requirement, set forth a new restriction requirement and withdrew claims 11-17 and 21-29 based upon a restriction requirement.

In the Fourth Office Action, the Examiner issued an inappropriate restriction requirement, and, the Applicant has distinctly and specifically pointed out the errors in that restriction requirement and requested reconsideration of the requirement. In the interest of speeding prosecution, the Applicant respectfully requests that the Fourth Office Action’s restriction be removed pursuant to 37 C.F.R. § 1.144.

## REMARKS

The Fourth Office Action removed claims 11-17 and 21-29 from prosecution based upon an inappropriate restriction requirement. The Applicant respectfully points out that there are two criteria for a proper requirement for restriction: (A) the inventions must be independent or distinct as claimed; *and* (B) there must be a serious burden on the examiner if restriction is required. Further, such a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search. *See* M.P.E.P. § 808.02. The Applicant respectfully points out that the Fourth Office Action makes no showing at all of a burden on the patent office. Without such a showing the restriction requirement is improper and the Applicant respectfully asks that the restriction be withdrawn.

The Fourth Office Action concluded that claims 21-29 are “directed to an invention that is independent or distinct from the invention originally claimed.” Further, the Fourth Office Action asserted that the Applicant constructively elected an invention other than that embodied in claims 21-29. At page 3, the Fourth Office Action states:

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly claims 21-29 are withdrawn from consideration...

The Applicant respectfully points out that an action on the merits has been received for, at least, claims 21-29. In the Second Office Action, the Examiner rejected claims 18-29 as being unpatentable under 35 U.S.C. § 103(a) over Eaton in view of Harns. This, of course, is an action on the merits with respect to claims 21-29.

Further, the invention of Group II, which includes claims 18-29 as defined by the restriction requirement, has been searched. In the First Office Action, the Examiner made a prior art rejection of claims 18-20. In the Second Office Action, the Examiner made an additional prior art rejection of claims 18-29. The Applicant notes that all references cited by the Examiner in the Second Office Action appeared on the search report in the First Office Action, which also included the search of the claims set forth in Group I (claims 11-17). The overlap of cited references in the First Office Action and the Second Office Action would be expected in any reasonable search by the Examiner.

Moreover, the issuance of an identical rejection for each of claims 18-21 and claims 21-29 in the Second Office Action suggests the Examiner recognized that the claims have several overlapping limitations. In fact, the claims in each of Group I and Group II have several common limitations (for example, “evaluating elements in a row-first order,” “identifying faulty ones of said elements,” and “generating a count of said indented fault elements”).

With respect to the restriction of claim 11-17, the Fourth Office Action states at page 4:

The inventions are distinct, each from the other because inventions Group II and Group I are related as process and apparatus for its practice. In this case the apparatus, Group I, can be used strictly for self-testing...the process, Group II, can be used in a self repair system.

The Applicant respectfully points out that in the First Office Action, the Examiner rejected Group I (claim 11-17) as being unpatentable under 35 U.S.C. § 102(b) as being anticipated by Harns. Thus, any search required for the present claims of Group I is presumed to have been performed in the search of the claims as they existed, in substantially the same form, at the time of the First Office Action. As a search has already been completed for both groups identified by the Examiner, there is no serious burden on the Examiner to examine the entire application on the merits.

For the reasons set forth above, namely, that the Applicant has received an action on the merits with respect to each group of claims now being restricted, that each group of restricted claims has already been examined, that each group of restricted claims has overlapping limitations, and that the Examiner cannot demonstrate the serious burden required to issue a restriction requirement, the restriction requirement is improper and Applicant respectfully requests that this petition be granted.

Finally, the Examiner has mischaracterized the Applicant's invention in issuing the restriction requirement. Specifically, the Examiner has stated that Group I can be used for “self testing, comprising a means or evaluation elements,” and Group II can be used “in a self-repair system, comprising a means for evaluating elements.” Such limitations do not appear in the claims of Group I or Group II, respectively, and are therefore inappropriate mischaracterizations of the claims of Group I and Group II.

For the reasons above, the Applicant believes the removal of claims 11-17 and 21-29 from prosecution based upon a restriction requirement is improper. Therefore, the Applicant respectfully requests the restriction requirement of record be withdrawn. The Applicant thanks the Commissioner for taking the time to review this petition and respectfully requests that this petition be granted 37 C.F.R. § 1.144.

The fee for the Petition is figured on the Transmittal sheet. At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account No. 08-2025, under Order No. 10004546-1, from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Label No. EV482709007US in an envelope addressed to: MS AF, Commissioner for Patents, Alexandria, VA 22313.

Date of Deposit: August 3, 2005

Typed Name: Elise Perkins

Signature: Elise Perkins

Respectfully submitted,

By: 

Michael A. Papalas  
Attorney/Agent for Applicant(s)  
Reg. No. 40,381  
Date: August 3, 2005  
Telephone No. (214) 855-8186